

Serial No. 10/064,350
Filed: 07/03/2003
Page 9 of 13

Examiner: Frank B. Vanaman
Group Art Unit: 3618

REMARKS

By the present amendment, the claims have been amended for purposes of clarity and to overcome the Examiner's objections and rejections under 35 U.S.C. § 112. It is believed that the claims are clear and overcome the Examiner's rejections under 35 U.S.C. § 112. The Examiner is thanked for the helpful suggestions in the Office Action.

The Examiner has objected to the term "relatively linear" in line 4 of claim 1. Applicant believes that this term not indefinite or confusing. This term is found in Webster's New Collegiate Dictionary, Copyright 1981:

3: not absolute or independent: Comparative <the ~ isolation of life in the country>

The term "relatively" is the adverb which modifies "linear." Thus, "relatively linear" means "not absolutely linear but substantially linear." It is believed that this term is not confusing. There is an ordinary meaning to this term and Applicant sees no reason to change this terminology.

It is noted that the Oath or Declaration is defective because it does not identify the citizenship of each inventor. Unfortunately, the Patent Office program that was used to file this application electronically, cut off the Applicant's citizenship. Enclosed herewith is a substitute Declaration that complies with 37 C.F.R. § 1.67(a).

In the Office Action, claims 1-10, 13, 14, 25, 26, 27, 31, 32, 33, and 51 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Zieske U.S. Patent No. 5,950,975 in view of the Laubach U.S. Patent No. 5,895,064. This rejection is respectfully traversed.

The Zieske '975 patent discloses an adjustable fender bracket formed by an elongate tubular arm having an inner end and an outer end wherein the tubular arm is bent such that a first longitudinal axis of the outer end is offset in substantially parallel relationship from a second longitudinal axis of the inner end. In addition, the elongate arm has a means for mounting the inner end thereof to the frame for rotational movement about the second longitudinal axis to selectively vary the vertical distance between the longitudinal axes. The tubular arm further has a plate attached to the outer end of the arm for selective rotational and longitudinal movement

Serial No. 10/064,350
Filed: 07/03/2003
Page 10 of 13

Examiner: Frank B. Vanaman
Gr up Art Unit: 3618

with respect to the outer end of the arm. Zieske '975 teaches that this fender bracket is adaptable for mounting a fender at a precise vertical and lateral position with respect to a vehicle frame. The bracket is height adjustable by mounting the inner end on a bolt about which the inner end can rotate about the second longitudinal axis. The outer end of the bracket is adjustable vertically by simply rotating the inner end of the bracket. Because the plate is rotatable about the outer end of the bracket, it can glide longitudinally along the inner end of the bracket as well as it rotates about the outer end of the bracket so that it matches the desired location of the fender. The Zieske bracket is complete and needs no further adjustments in order to accommodate a fender in various different positions.

The Laubach '064 patent relates to a universal mounting bracket for running boards in which the bracket is formed by two channel shaped members, the inner end of which is attached to the underside of the frame with a vertically disposed bolt and the outer end of which is attached to the underside of the running board also with a vertically disposed bolt. Each of the bracket portions is bent at about a 45° degree angle and the angular portions of the bracket are slidable within one another and fastened together in a selected position with bolts. There is no rotatability of the bracket about the frame or the running board.

The combination of Zieske '975 with Laubach '064 is traversed. There is no basis for making the alleged combination. There is no suggestion in either of the references which would suggest their combination. When one reads the Zieske '975 patent, it is clear that the Zieske bracket is capable of all necessary vertical and lateral adjustments in order to satisfy the function of adjustably mounting a fender to a frame. The inner end of the Zieske bracket is rotatable about a horizontal axis to provide the vertical adjustment function for the outer end. The plate on the outer end of the Zieske bracket can move toward and away from the frame as well as about the horizontal axis of the outer end of bracket to accommodate the forward, central and rear portions of the fender. By the same token, the Laubach '064 patent is also complete. It accommodates vertical and horizontal adjustments with the inclined telescoping bracket portions.

The Laubach '064 running board mounting bracket has no relationship to a mounting bracket for a fender. Both the inner and outer ends of the bracket are fastened to the frame

Serial No. 10/064,350
Filed: 07/03/2003
Page 11 of 13

Examiner: Frank B. Vanaman
Group Art Unit: 3618

through vertically mounted bolts. There is no rotation of the bracket about the frame. Nor is there any rotation of the running board about the bracket. It is an entirely different kind of bracket than the tubular Zieske '975 bracket. Laubach requires the adjustment along the angled portions of the bracket in order to accommodate different truck frames and running boards. There is no suggestion in Laubach of using this bracket for mounting a fender to a vehicle. The two brackets are entirely different and function in a different way.

In order to tenably combine references, there must be some suggestion in the references in order to make a tenable combination of disclosures. *In re Sang-Su Lee*, 277 F.3d 1338, 56 USPQ2d 1430 (Fed. Cir. 2000); *Ecolochem, Inc. v. Southern California Edison Company*, 277 F.3d 1361, 56 USPQ2d 1065 (Fed. Cir. 2000). As aptly stated by Judge Newman in *Sang-Su Lee*:

...The patent examination process centers on prior art and the analysis thereof. When patentability turns on question of obviousness, the search for an analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. . . .

"The factual inquiry whether to combine references must be thorough and searching." [Citation omitted] It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions and cannot be dispensed with. ... *In re Dembiczak* 175 F.3d. 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against subtle but powerful attraction of a hindsight based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.")

In accordance with the admonition of *In re Sang-Su Lee, supra*, the Laubach '064 reference cannot be tenably combined with the Zieske '975 reference. There is no suggestion or motivation for this combination because the Zieske adjustable fender bracket accommodates the height and length adjustment that would be provided by Laubach '064. The alleged combination is inappropriate.

In view of the foregoing, it is submitted that claims 1-10, 13, 14, 25, 26, 27, 31, 32, 33, and 51 are patentable over the alleged combination of Zieske '975 in view of Laubach '064.

Serial No. 10/064,350
Filed: 07/03/2003
Page 12 of 13

Examiner: Frank B. Vanaman
Group Art Unit: 3618

Claims 15, 16, 17, 19, and 34-37 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Zieske '975 in view of Laubach '064 and further in view of the Laribee U.S. Patent No. 4,181,293. This rejection is respectfully traversed. The Laribee '293 patent relates to a hand rail support hardware wherein two brackets have serrated edges that engage one another.

The alleged combination of Zieske in view of Laubach and Laribee is traversed. There is no basis for making the alleged combination. Indeed, there is no suggestion in any of the references which would warrant their alleged combination.

The uncombinability of Zieske and Laubach has been discussed above and that discussion is applicable in this rejection as well. The Laribee '293 reference is even more remote than the Laubach '064 patent to the Zieske '975 fender mounting bracket. The mere selection of Laribee '293 as a prior art reference against claims 15, 16, 17, 19, and 34-37 is about the clearest example that one could imagine of an attempt at hindsight reconstruction of Applicant's claims by using Applicant's claims as a blueprint. The alleged combination clearly does not comport with *In re Su-Sang Lee* or *Ecolochem*.

For the foregoing reasons, it is submitted that claims 15, 16, 17, 19, and 34-37 patentably define over any tenable combination of Zieske '975, Laubach '064, and Laribee '293.

Claim 30 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Zieske '975 in view of Laubach '064 and further in view of the Lengd Kalinin Poly Soviet Union Publication No. 925-727. This rejection is respectfully traversed.

The Lengd Kalinin Poly '727 reference discloses a fender mounting which includes a spring at a central portion between a support art and an inner portion of each of two fenders. The other end of each fender is mounted on a swivel. The purpose of the spring and the swivel mounting is to provide a yieldable support for the fenders in the event that the wheels contact the fenders. The spring 22 is not a vibration decoupling connector. A vibration decoupling connector is an elastomeric pad, for example, that isolates the fender from the mounting bracket. No such decoupler is disclosed in the Lengd Kalinin Poly '727 reference.

The alleged combination of Zieske '975 with Laubach '064 and Lengd Kalinin Poly '727 is traversed. There is no basis for making the alleged combination. The uncombinability of

Serial No. 10/064,350
Filed: 07/03/2003
Page 13 of 13

Examiner: Frank B. Vanaman
Group Art Unit: 3618

Zieske '975 and Laubach '064 has been discussed and that discussion is equally applicable here. Even more remote is the combinability of Lengd Kalinin Poly '727 with either of these references. There is no suggestion as to how the mounting spring would be incorporated into the Zieske '975 adjustable fender bracket.

Even if the combination were to be made, however untenably, it still would not reach Applicant's claimed invention. The alleged combination would not have a vibration decoupling connector connecting the support arm to the fender as required by claim 30.

Applicant notes with appreciation that claims 11, 12, 18, 20-24, 28, 29, and 38-50 would be allowable if rewritten to overcome the rejections under 35 U.S.C. § 112 second paragraph set forth in the Office Action and to include all of the limitations of base claim and any intervening claims. In view of Applicant's belief that the base claim as well as the intervening claims are allowable, these claims have not been rewritten in independent form.

It is noted that the examiner did not indicate that the drawings were acceptable or unacceptable. Applicant assumes that the drawings are acceptable but would the Examiner's confirmation of this fact.

In view of the foregoing remarks and amendments, it is submitted that all of the claims are in condition for allowance. Should the Examiner believe that the claims are not in condition for allowance for some reason, the courtesy of a telephone interview prior to the issuance of a final rejection is respectfully requested.

Respectfully submitted,

Timothy B. Hawes

Dated: 4-19-04

By: 

John E. McGarry, Reg. No. 22,360
McGARRY BAIR PC
171 Monroe Avenue, NW, Suite 600
Grand Rapids, Michigan 49503
616-742-3500

G0123880